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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/444,711	11/24/1999	TIMOTHY J. YEATMAN	114205.400	9003

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SALIWANCHIK LLOYD & SALIWANCHIK  
A PROFESSIONAL ASSOCIATION  
2421 N.W. 41ST STREET  
SUITE A-1  
GAINESVILLE, FL 326066669

EXAMINER

HARRIS, ALANA M

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/444,711	YEATMAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alana M. Harris, Ph.D.	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 23 June 2003 and 02 July 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 113-153 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 113-128 and 147-153 is/are allowed.

6) Claim(s) 129, 130, 132-138 and 140-146 is/are rejected.

7) Claim(s) 131 and 139 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121..

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Response to Arguments and Amendment***

1. Claims 113-153 are pending.

Claims 39-112 have been cancelled.

Claims 113-153 have been added.

Claims 113-153 are examined on the merits.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Withdrawn Rejections***

#### ***Claim Rejections - 35 USC § 112***

3. The rejection of claims 39, 40, 42, 44, 45, 47, 49-52, 54, 56-58, 61, 62, 66 and 67 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is withdrawn in light of the cancellation of the claims.

4. The rejection of claims 51-56 and 66-69 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention is withdrawn in light of the cancellation of the claims.

5. The rejection of claims 57-60 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in light of the cancellation of the claims.

***Claim Rejections - 35 USC § 102***

6. The rejection of claims 57-65 under 35 U.S.C. 102(b) as being anticipated by the 1997/1998 Stratagene catalog (page 118, 1997/1998) is withdrawn in light of the cancellation of the claims.

***Claim Rejections - 35 USC § 103***

7. The rejection claims 57-65 under 35 U.S.C. 103(a) as being unpatentable over 1997/1998 Stratagene catalog (page 118, 1997/1998) is withdrawn in light of the cancellation of the claims.

***New Grounds of Rejection***

***Claim Rejections - 35 USC § 102***

8. Claims 129, 130, 132-138 and 140-146 are rejected under 35 U.S.C. 102(b) as being anticipated by the 1997/1998 Stratagene catalog (page 118, 1997/1998). In anticipation of the instant rejection Applicants argue patent law and that "...a single reference must disclose ...each and every element and limitation contained in the rejected claims". These arguments have been considered but found unpersuasive.

The 1997/1998 Stratagene catalog discloses the Prime-It® II Random Primer Labeling Kit containing an instruction manual and hexanucleotides containing all

possible 6-nucleotide sequences and inherently would be capable of recognizing and distinguishing a mutant c-Src gene comprising nucleotides 1 to 1593 of SEQ ID NO: 3 which encodes mutant polypeptide SEQ ID NO: 4. The fact that the hexanucleotides contain all possible nucleotide sequences supports the technical reasoning that the taught hexanucleotides would act in the manner characteristic of Applicants' claimed oligonucleotide.

***Allowable Subject Matter***

9. Claims 113-128 and 147-153 are allowed.
10. Claims 131 and 139 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

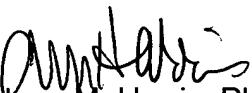
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris, Ph.D. whose telephone number is (703) 306-5880. The examiner can normally be reached on 7:00 am to 4:30 pm, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D. can be reached on (703) 308-3995. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0196.



Alana M. Harris, Ph.D.  
23 September 2003